REMARKS

These remarks are set forth in response to the First Office Action. As this amendment has been timely filed within the three-month shortened statutory period, neither an extension of time nor a fee is required. At the time of the First Office Action, Claims 1 through 13 were pending and rejected in this application. Claims 1, 7 and 8 are independent.

CLAIMS 1-6 AND 8-13 ARE REJECTED UNDER 35 U.S.C. § 102(B) AS BEING ANTICIPATED BY U.S. PATENT NO. 5,651,058 TO HACKETT-JONES, ET. AL. (HEREINAFTER HACKETT-JONES)

On pages 2-3 of the First Office Action, the Examiner asserted that Hackett-Jones discloses the invention corresponding to that claimed in Claims 1-6 and 8-13. This rejection is respectfully traversed.

The factual determination of anticipation under 35 U.S.C. § 102 requires the identical disclosure, either explicitly or inherently, of each element of a claimed invention in a single reference[1]. Moreover, the anticipating prior art reference must describe the recited invention with sufficient clarity and detail to establish that the claimed limitations existed in the prior art and that such existence would be recognized by one having ordinary skill in the art[2]. As part of this analysis, the Examiner must (a) identify the elements of the claims, (b) determine the meaning of the elements in light of the specification and prosecution history, and (c) identify

[1] In re Rijckaert, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); Perkin-Elmer Corp. v. Computervision Corp., 732 F.2d 888, 894, 221 USPQ 669, 673 (Fed. Cir. 1984).

[2] See In re Spada, 911 F.2d 705, 708, 15 USPQ 1655, 1657 (Fed. Cir. 1990); Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 678, 7 USPQ2d 1315, 1317 (Fed. Cir. 1988).

corresponding elements disclosed in the allegedly anticipating reference.[3] This burden has not been met.

Claim 1

At the outset, Applicants note that amendments have been made to Claims 1, 7 and 8. Amended independent Claim 1 recites the following:

> A method for managing delivery service instructions, the method comprising:
> prompting a customer through an established telephone call to manage delivery instructions corresponding to a previously ordered good or service without first prompting said customer for identifying information; and,
> managing said delivery instructions without accessing customer information derived through said phone call.

On page 2 of the First Office Action, the Examiner relied upon Fig. 2A, box 21, box 22 and col. 2, lines 25-31; and Fig. 2A, box 25, and col. 2, lines 30-39 to teach the limitations of Claim 1. Several of the passages are reproduced here for convenience.

> In accordance with the invention the automatic exchange system is also able to perform a management function in establishing the identity of a calling party in terms of the relevant hotel room number, establishing the status of the corresponding hotel room, for example whether the hotel room is vacant or is validly let to a hotel guest, and providing a corresponding message to a calling party. Thus, for example, if a call is received from a hotel room identified as vacant and not having valid status for the establishment of a call to the interactive service, a message can be returned indicating that the requested call cannot be connected. If the status of the calling room is valid, then a message can be returned offering a variety of services to the caller, and requesting transmission of a signal selecting a corresponding service col. 2, lines 25-39.

As claimed, the method for managing delivery service instructions includes "prompting a customer through an established telephone call to manage delivery instructions corresponding to

[3] Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984)

a previously ordered good or service without first prompting said customer for identifying information." The cited figures and passages of Hackett-Jones at Fig. 2A, box 21, box 22 and col. 2, lines 25-31; and Fig. 2A, box 25, and col. 2, lines 30-39, fail to teach or suggest method for managing delivery service instructions including prompting a customer through an established telephone call to manage delivery instructions corresponding to a previously ordered good or service without first prompting said customer for identifying information. To the extent that the cited figures and passages of Hackett-Jones at Fig. 2A, box 21, box 22 and col. 2, lines 25-31; and Fig. 2A, box 25, and col. 2, lines 30-39, even teach "manag(ing) delivery instructions" at all is respectfully traverse; however, these cited figures and passages of Hackett-Jones clearly do not teach "manag(ing) delivery instructions corresponding to a previously ordered good or service". In contrast, Hackett-Jones teaches selecting for the first time an option for various services illustrated in FIG. 2A, box 25.

Claims 2-6, and 8-13

Claims 2-6 and 8-13 all recite the limitations of:

> prompting a customer through an established telephone call to manage delivery instructions corresponding to a previously ordered good or service without first prompting said customer for identifying information.

Accordingly, for at least the reasons discussed with respect to amended Claim 1, Claims 2-6 and 8-13 are patentable over Hackett-Jones, and allowance is respectfully requested.

CLAIM 7 IS REJECTED UNDER 35 U.S.C. § 103 AS BEING UNPATENTABLE OVER HACKETT-JONES IN VIEW OF U.S. PATENT 6,418,216 TO HARRISON, ET AL. (HEREINAFTER HARRISON)

Claim 7 is amended to recite the limitation of "a plurality of customers calling a delivery service instructions management system over a public switched telephone network (PSTN) to manage respective delivery instructions corresponding to previously ordered goods or services".

Accordingly, the teachings of U.S. Patent No. 6,418,216 to Harrison, et al., (hereinafter Harrison) cannot overcome the deficiencies of Hackett-Jones, with respect to amended Claim 7, therefore Applicants respectfully request that the imposed rejection of Claim 7 under 35 U.S.C. § 103 for obviousness based on Hackett-Jones in view of Harrison in not viable and, hence solicit withdrawal thereof.

For the above reasons, the Applicant respectfully requests the withdrawal of the rejections under 35 U.S.C. §§ 102(b) and 103(a). This entire application is now believed to be in condition for allowance and such action is respectfully requested. The Applicants request that the Examiner call the undersigned if clarification is needed on any matter within this Amendment, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

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/Steven M. Greenberg/

Steven M. Greenberg
Reg. No.: 44,725
Customer Number 46322
Attorney for Applicant(s)
Carey, Rodriguez, Greenberg & Paul, LLP
950 Peninsula Corporate Circle, Suite 3020
Boca Raton, FL 33487
Tel: (561) 922-3845
Fax: (561) 244-1062